

REMARKS

Status of the Claims

Claims 1, 2, 5-9, 11 and 16-42 are pending.

No new matter has been added

Applicants submit that no amendments have been made by way of the present submission, thus no new matter has been added.

No new issues have been raised

Applicants submit that no new issues have been raised by way of the present submission which would require additional search and/or consideration on the part of the Examiner. In the event the present submission does not place the application into condition for allowance, entry thereof is requested as placing the application into better form for appeal.

In view of the following remarks, the Examiner is respectfully requested to withdraw all outstanding rejections.

Issues Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 20-42 under 35 U.S.C. § 112, first paragraph, asserting that the claims contain

subject matter which was not described in the specification. In particular, the Examiner asserts that the original claims referred to G<sub>1</sub>, G<sub>2</sub>, G<sub>3</sub> and G<sub>4</sub> as having one or two nitrogen atoms. However, the present claims 20-42 allow for three or four nitrogen-containing rings, which is allegedly not supported. Applicants respectfully traverse this rejection.

Originally filed claim 1 allowed for each of G<sub>1</sub>, G<sub>2</sub>, G<sub>3</sub> and G<sub>4</sub> to be a nitrogen atom. The claims were only subsequently narrowed during prosecution. The present specification, for instance, page 14, line 15 specifically supports the subject matter of claims 20-42, with respect to G<sub>1</sub>, G<sub>2</sub>, G<sub>3</sub> and G<sub>4</sub>, each being nitrogen. Accordingly, one having ordinary skill in the art would have recognized that Applicants were in possession of the claimed subject matter at the time of filing. Thus, this rejection is improper and should be withdrawn.

Objection to the Claims

The Examiner has objected to claim 17 asserting that a formula is missing and should be inserted. Applicants traverse and submit that the Examiner does not appear to have taken into account the amendment submitted on May 30,

2003, which corrected this issue. Appropriate correction is requested.

Allowable Subject Matter

The Examiner indicates that claims 1, 2, 5-9, 11, 16, 18 and 19 are allowable. Applicants further submit that claims 20-42 are likewise allowable.

Potential Interference

The Examiner indicates that a potential interference exists with respect to U.S. Patent No. 6,403,595 (Tawada '595). The Examiner asserts that usually there will only be two or three counts and thus requests the cancellation of claims 20-42. The Examiner suggests that Applicants copy claims which are closest to the common species and have support in the instant specification. Applicants disagree with the Examiner's reasoning in part. Although Applicants agree that a potential interference with respect to Tawada '595 may exist, Applicants do not agree that claims 20-42 should be cancelled.

Claims 20-42 were filed in order to preserve Applicant's rights under 35 U.S.C. § 135(b). Thus, the primary purpose behind filing claims 20-42 was to present claims, which covered the subject matter held in common

with the issued claims of Tawada '595. However, the secondary purpose behind these claims was to cover subject matter which is specifically supported by the present application and which is suitable for a count in any possible subsequent interference with Tawada '595.

If the Examiner believes that claims 20-42 are unpatentable or the scope of claims 20-42 is unsuitable for the count, Applicants request that the Examiner propose an alternative count. However, as indicated above, the scope of claims 20-42 corresponds to compounds supported by the present application, which overlap with compounds falling within the scope of the issued claims of Tawada '595. Thus, independent claim 20, the broadest product claim, appears suitable for a count. If the Examiner is of the opinion that other claims define inventions which are patentably distinct, the Examiner may suggest additional counts.

In summary, the Examiner is respectfully requested to withdraw all outstanding rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact the undersigned at the Offices of Birch, Stewart, Kolasch & Birch, LLP

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
for   
Gerald M. Murphy, Jr.  
Reg. No. 28,977

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

GMM/CAM/gh